

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In Re Application of:

Daniel Castro et al.

Examiner: Michener, Jennifer Kolb

Serial No.: 10/602,487

Art Unit: 1762

Filed: 6/23/03

Title: Method For Depositing A Coating Onto A Surface Of A Prosthesis

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Restriction Requirement

Dear Examiner Michener:

In response to the restriction requirement dated September 1, 2005, Applicants elect Group I, species of the dispenser not being in contact with the stent. Applicants do traverse the restriction requirement on the following grounds and do request reconsideration and withdrawal of the restriction requirement.

First, the Examiner has stated that "the different inventions are not disclosed as capable of use together and have different modes of operation." More specifically, the Examiner has stated that Groups I and III require causing the dispenser to be moved, which is not required by Groups II and IV. This statement is incorrect. Claim 120 of Group II requires the dispenser to move independently of the stent. Claims 173, 174, and 179 of Group IV require the dispenser to move.

The Examiner has stated that Groups II and IV require causing the stent to be moved, which is not required by Groups I and III. Again, this statement is incorrect. Claim 103 of Group I requires the stent to be moved independently of the dispenser. Claims 161 and 162 of Group III require movement of the stent.

The Examiner has stated that Groups III and IV include operation of a computer, which is not required by Groups I and II. Again, this statement is in error. Claims 104, 105, 137, 138, and 140, for example, of Group I require a computer for movement and/or operation of the dispenser. Claims 121, 122, 144, and 145, for example, of Group II require a computer for movement and/or operation of the stent.

The Examiner has stated that Groups III and IV require movement from a first to a second position along a framework which is not required by Groups I and II. Again, this statement is incorrect. Claim 101 of Group I requires movement from a first position to a second position along a frame structure. Claim 117 of Group II requires movement between a first position and a second position along a frame structure.

Considering that the inventions of each group are demonstrated as being used together, including modes of operation that work in concert with each other, Applicants respectfully fail to find any validity or merit in the statements made by the Examiner. As illustrated by the Applicants, the statements made by the Examiner are factually incorrect.

Second, 35 U.S.C § 121 states that the Commissioner may require restriction of the claims if the inventions are “independent and distinct.” The Guideline provides that “the examiner must provide reasons and/or examples to support [this] conclusion.” Applicants respectfully submit that Examiner has failed provide any support as to why the inventions are “independent and distinct” as mandated by the MPEP. The statements made on page 3 of the

office action fail to fit into any of the guidelines provided by chapter 800 of the MPEP.

Applicants respectfully submit that the Examiner's statements appear to be subjective and arbitrary distinctions, without regard to the guidelines mandated by chapter 800 of the MPEP. Should the restriction requirement be maintained, Applicants do request a citation to the proper section of chapter 800 of the MPEP in support of the Examiner's position.

Third, as indicated above, the test is whether the inventions are "independent **and** distinct." (emphasis added). Applicants do submit that the inventions are distinct -- or in other words **are patentable over each other**. Groups I-IV include claims that are patentably different from each other; however, the test is not whether the inventions are independent **or** distinct, it is whether the inventions are independent **and** distinct. Independent is defined as the inventions having no disclosed relationship between one another. Applicants have clearly shown that there is a relationship between the various inventions by the mere fact of overlapping dependent subject matter.

Fourth, the MPEP is very clear as to the criteria for restriction between patentably distinct inventions -- namely, (1) the inventions must be independent and distinct; and (2) **there must be a serious burden on the Examiner**. Applicants respectfully fail to see how a "serious burden has been placed on the Examiner." In conducting a search for the claims of Group I, the Examiner has to also search subject matter that overlaps with Groups II, III and IV. To pose this more concretely, as for Group I, based on the subject matter of claim 103, the Examiner is required to search for and find a reference that teaches movement of a dispenser as well as a stent. As for Group II, based on the subject matter of claim 120, the Examiner is still required to search for and find a reference that teaches movement of a stent as well as a dispenser. Considering the

overlapping subject matter presented by the dependent claims, the search conducted by the Examiner inevitably covers all 4 groups.

Moreover, the Examiner has already conducted a search and submitted an office action on the merits of the claims. Furthermore, the same Examiner examined the parent application having the same type of division in the claims. Considering that the Examiner has already conducted a search and issued an office action, and further considering that the Examiner made absolutely no objections in the parent application, Applicants respectfully fail to see how a serious burden is now all of a sudden being placed in the Examiner. Finally, according to the Examiner, all four groups fall under class 427, subclass 2.1. Considering that the Examiner need not even venture out of the same subclass for all 4 groups, Applicants submit that this restriction requirement is not appropriate and should not have been imposed on the Applicants.

Applicants submit that claims 94-109, 127-130, 135, 137-143, 148, 150, 152, 154, 155, and 158 are readable on the group and species elected.


If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (415) 954-0323.

If for any reason an insufficient fee has been paid, the Commissioner is hereby authorized to charge the insufficiency to Deposit Account No. 07-1850.

Date: December 22, 2005

Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111
Telephone (415) 954-0323
Facsimile (415) 393-9887

Respectfully submitted,


Cameron Kerrigan
Attorney for Applicants
Reg. No. 44,826